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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,450	07/21/2003	Hideki Saga	29284/592	5239
23838	7590	12/12/2007	EXAMINER	
KENYON & KENYON LLP			CHU, KIM KWOK	
1500 K STREET N.W.				
SUITE 700			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			2627	
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			12/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/622,450	Applicant(s) SAGA, HIDEKI	
	Examiner Kim-Kwok CHU	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 10/16/2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,8,12-20 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,12-16 and 33-37 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/583,480.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination after Final Rejection***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2007 has been entered.

***Response to Remarks***

2. Applicant's Remarks filed on October 16, 2007 have been fully considered but it is not persuasive. With respect to the amended Claim 1, Applicant states that the prior art of Toda makes no mention of whether or not the target track is changed during a trail pattern is written and then reproduced (page 9 of the Remarks, second paragraph, lines 5-7). Accordingly, in the present amended Claim 1, Applicant does not claim the target track is changed/unchanged. Instead, Applicant claims "a target condition of a track following operation ..... is unchanged" (Claim 1, lines 16 and 17). As long as a pickup is scanning a recorded data within a spiral track, the pickup is in a proper tracking condition and such track following operation is considered in a state of

unchanged.

Applicant further states that the prior art Toda reproduces recorded signal without a track jumping operation is inconceivable (page 9 of the Remarks, second paragraph, last two lines). Accordingly, if a test pattern is written continuously within a spiral track, there is no need to perform a track jump. In fact, the prior art of Toda teaches that "one track in at least one sector or the whole circumferential portion of one track is provided as a test track....." (column 6, lines 44-45). In other words, Toda reproduces the test track's signal without a track jump because all the test signals are written within the test jump.

With respect to the amended Claims 8, 12-16 and the new Claims 33-37, the prior art of Toda teaches the subject matter as in above explanation to Applicant disagreement on the rejection of his Claim 1.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

4. Claims 1, 8, 12-16 and 33-37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Toda et al. (U.S. Patent 5,642,343).

Toda teaches an information recording apparatus for recording information on a recording medium having all the elements and means as recited in claims 1 and 8. For example, Toda teaches the following:

(a) With respect to Claim 1, the information recording apparatus for recording information on a recording medium 101 by forming marks different in a physical property from non-recorded portions (test areas) with energy injected into the recording medium 101 (Figs. 1 and 5; different size of marks are formed in a test track; column 6, lines 37-40); energy generation means 8 (laser in optical head 2) which generates recording energy (Fig. 1); Reading means 2, 9 which read marks recorded on the recording medium (Figs. 1 and 5); position control means (to drive optical pickup 2 as in Fig. 27) which

controls an injection position of the recording energy output from the energy generation means 8 for the recording medium 101 and controls a reading position of the reading means (Figs. 1 and 27; focusing and tracking controls are inherent features in the pickup 2); drive means 7 which drives the energy generation means 8 (Fig. 1); a switching means (in encoder 4) which selectively switches information based on user's data or test information to be supplied to the drive means (Fig. 1; input of the encoder 4 is a switching means so that either input data or trial writing data is selected to encoded); an evaluation means 16 which evaluates a reproduced signal amplitude obtained from the reading means 10 (Fig. 1); a recording condition control means 6, 11, 13 which controls a recording condition in accordance with an evaluation result obtained from the evaluation means 16 (Figs. 1 and 2; steps 2023, 2026 and 2027); in a case of reproducing the marks having the test information (Fig. 2, step 2026), a target condition of a track following operation of the position control means is unchanged in a first reproduction in comparison with a time when the test information is recorded (Figs. 1 and 2; test recording signals are recorded and then reproduced without involving track jumping operation); and changed in a second reproduction in comparison with a time when the test information is recorded (Fig. 2; control means

such as a tracking servo is repeated/restarted; steps 2026, 2027); the recording condition is controlled in accordance with a signal amplitude (light intensity) in the first reproduction and a signal amplitude in the second reproduction (Figs. 2 and 5; light intensities to form marks are determined after repeated test recording).

(b) With respect to Claim 8, means for vibrating an optical spot in a direction perpendicular to a track scanning direction and in parallel with a recording medium (Fig. 1; the inherent tracking servo which moves in a direction parallel to the medium).

5. Method Claim 12 is drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore method claim 12 corresponds to apparatus claim 1 and is rejected for the same reasons of anticipation as used above.

6. Method Claim 13 depends on method Claim 12 and therefore also drawn to the method of using the corresponding apparatus claimed in claim 1. Claim 13 however also recites the following limitation which is also taught by the prior art of Toda:

(a) with respect to Claim 13, in the first and second reproduction steps, either a tracking offset amount or a tracking polarity, or a stop or start of a tracking operation is changed (Fig. 2; control means such as a tracking servo is repeated/stop or start).

7. Claims 14 and 15 have limitations similar to those treated in the above rejection as in Claim 1, and are met by the reference as discussed above. Claims 14 and 15 however also recite the following limitation which is also taught by the prior art of Toda:

(a) with respect to Claims 14 and 15, the changed content of the control operation for the position control means is a tracking offset amount of the track following operation carried out by the position control means (Figs. 1 and 2; control means such as a tracking servo inherently offset the tracking operation or switch its polarity based on an even/odd track).



8. Claim 16 has limitations similar to those treated in the above rejection as in Claims 1 and 6, and are met by the reference as discussed above.

9. Claims 33-37 have limitations similar to those treated in the above rejection as in Claims 1 and 13-15, and are met by the reference as discussed above.

***Allowable Subject Matter***

10. Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is an Examiner's statement of reasons for the indication of allowable subject matter:

As in claims 17-20, the prior art of record fails to teach or fairly suggest an information recording apparatus having the following features: in a case where the test information is supplied to the drive means and recorded on the recording medium, the test information inconsistent with a conversion rule of a conversion means is used, wherein test information containing a longer run-length than a run-length rule of the conversion means is used as the test information.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

Kim-Kwok CHU

*12/9/07*  
Examiner AU2627  
December 9, 2007

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*TAN DINH*  
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PRIMARY EXAMINER

*12/10/07*